

REMARKS

Reconsideration of the application is requested.

Claims 1-4 remain in the application. Claims 1-4 are subject to examination.

Under the heading "Claim Rejections - 35 USC § 103" on pages 2 and 3 of the above-identified final Office Action, claims 1-4 have been rejected as being obvious over U.S. Patent No. 6,205,124 to Hamdi (hereinafter Hamdi) in view of U.S. Patent No. 6,163,531 to Kumar (hereinafter Kumar) under 35 U.S.C. § 103.

First, applicant respectfully states that neither Hamdi nor Kumar are believed to offer any motivation that would give a person of ordinary skill in the art any reason to combine Hamdi with Kumar in the manner exemplified by the Examiner.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ

543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be '**clear and particular.**'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Hamdi to incorporate the features of a multimedia terminal for telephony based on ITU-T Standard H.323 for setting up a multipoint connection to a plurality of terminals, and there is no teaching or suggestion in Kumar to incorporate these features in Hamdi.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the **applicant's** disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), *cert. den.*, 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to combine Hamdi's and Kumar's teachings to arrive at the claimed invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Hamdi or Kumar from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed

invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

More specifically, the motivation "to provide a multipoint conference system without subscribing to a service provider" as indicated by the Examiner would not give a person of ordinary skill in the art any reason to combine Kumar with Hamdi because in Kumar a service provider (ISDN-network 150, ATM network 160 and PSTN network 170 in Fig. 1 of Kumar) is necessary for the purpose of communicating with remote subscribers (152, 162, 172 in Fig. 1). Therefore, a person of ordinary skill in the art who would want to realize a conferencing circuit in Hamdi with remote subscribers (remote DSVD 180, 188 in Fig. 2a in Hamdi) without falling back on a service provider, would not find anything in Kumar.

The above motivation tendered by the Examiner, further does not explain why a person of ordinary skill in the art would only have extracted the isolated feature of "H.323" from Kumar and not also the other features which are tightly

connected in a technical sense with the H.323 standard taught in Kumar, such as, for example, the central H.323 conference device (MCU). The indicated motivation does not supply a criterion for a preference of the isolated feature "H.323" as compared to, for example, the feature of a central H.323-MCU. The selection made by the Examiner of an isolated feature from Kumar respectfully is believed to correspond to an inadmissible hindsight consideration (pick and choose). In the meantime, the implementation of a central H.323-MCU according to Kumar - as already explained in our previous response - leads away from the object of the application. Kumar actually teach away from Hamdi because Kumar requires a conference service centrally located in the network. This means that the advantage of a functionality, which is transferred to a terminal, which does not require access to a central conference service, is lost in Kumar. Otherwise, neither Hamdi nor Kumar contains information as to why Kumar should only carry out the conversion to H.323, but not the central conference device, which is provided according to H.323.

Furthermore, the H.323 technology disclosed in Kumar is purely based on digital data packet transport and this not believed to be compatible in a technical sense with the conference system in Hamdi that is based on the specific

analog modems. The objects disclosed in Hamdi and Kumar are based on entirely different technologies. Due to the fact that the H.323 standard does not only describe an individual communication terminal but an entire communication infrastructure, Hamdi's entire circuit structure would have to be considerably changed for implementing the H.323 standard in Hamdi. However, neither Hamdi nor Kumar contain any information which would have actually given a person of ordinary skill in the art any reason or would have motivated the person of ordinary skill in the art to such an extraordinary redesigning. Furthermore, as noted in MPEP 2143.02, the proposed modification cannot change the principle of operation of the primary reference (Hamdi). Clearly, in order to incorporate the H.323 standard in Hamdi, the original invention in Hamdi is modified to such an extent that it no longer functions as originally designated.

Finally, it is noted that the Examiner maintains his assertion in the last paragraph of item 2 by stating that "Hamdi suggests that DSVD multipoint control unit of a terminal using ITU for processing the setup of a teleconference between the terminals." Contrary to the Examiner's statement, Hamdi does not propose to configure a telephone conference according to an ITU standard. Instead, ITU standards are mentioned in Hamdi exclusively in context

with types of modulation that allow for a parallel transmission of voice and data via a voice frequency band. Only the ITU-T-recommendation V.70 is explicitly indicated, which pertains to the above-mentioned DSVD technology (digital simultaneous voice and data). See col. 1, lines 49-66. This ITU standard has nothing to do with configuring teleconferences, but pertains to a DSVD on-off operations (see, for example, col. 2, lines 20-23 in Hamdi). The mere mentioning of the ITU-T-V.70 standard in Hamdi does not suggest the use of the H.323 standard, which differs therefrom, because the V.70 standard pertains to a completely different technical problem than the H.323 standard on which the invention is based.

For the above state reasons, the Examiner is respectfully requested to withdraw the refusal.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1.

Appl. No. 09/441,535
Amdt., Dated September 14, 2004
Reply to Office Action of June 15, 2004

In view of the foregoing, reconsideration and allowance of
claims 1-4 are solicited.

If an extension of time is required, petition for extension
is herewith made. Any extension fee associated therewith
should be charged to the Deposit Account of Lerner and
Greenberg, P.A., No. 12-1099.

Please charge any other fees that might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner
and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



For Applicants

REL:cgm

September 14, 2004

Lerner and Greenberg, P.A.
P.O. Box 2480
Hollywood, Florida 33022-2480
Tel.: (954) 925-1100
Fax: (954) 925-1101